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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,556	08/24/2000	Jakob Scharf	194344US0	2549

22850 7590 08/14/2002

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EXAMINER	
TOOMER, CEPHIA D	
ART UNIT	PAPER NUMBER
1714	6

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-61 is/are pending in the application.
- Of the above claim(s) 51-61 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6, 8-10, 12, 13, 22, 24-27, 29-34, 36-38, 40, 49 & 50 is/are rejected.
- ☒ Claim(s) 7, 11, 14, 21, 23, 35, 39, 41-48 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-50, drawn to stabilized monomer composition and process for the synthesis of said composition, classified in class 252, subclass 182.29+
- II. Claims 51-61, drawn to process for synthesis of a 2-hydroxyalkyl (meth)acrylate, classified in class 560, subclass 128+.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of claims 1-50 can be made by another and materially different process, such as by the use of a different ethylenically unsaturated monomer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kirsten A. Grueneberg on June 26, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-50. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 51-61 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8-10, 12, 13, 22, 26-33, 36-38, 40 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halle (6,020,385).

Halle teaches microencapsulated monomers containing a polymerization inhibitor (see abstract). The monomers comprise, styrene, vinyltoluene, alpha methylstyrene, chlorostyrene, (meth) acrylic acid or esters, (meth) acrylamide, etc. (see col. 1, lines 46-63). The monomers may be admixed with a solvent, such as hexane, methyl ethyl ketone, etc. (see col. 2, lines 62-67). The polymerization inhibitor may include N, N-diethyl hydroxylamine or N- nitrosophenylhydroxylamine or the ammonium or aluminum salt thereof (see col. 3, lines 14-41). The inhibitor is present in the composition in an

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amount from 10 to 1000 ppm (see col. 3, lines 57-65). The composition also contains phosphate buffers (col. 4, lines 29-34). Halle teaches the limitations of the claims other than the difference that is discussed below.

Halle differs from the claims in that he does not specifically teach a monomer composition wherein both inhibitors are present. However, it would have been obvious to one of ordinary skill in the art to have used both inhibitors because it is prima facie obvious to combine two components each which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose.

Claims 1-6, 8, 13, 24-27, 29-34, 36 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 467850.

EP teaches a monomer composition comprising an ethylenically unsaturated monomer and polymerization inhibitors (see abstract). The inhibitors are phenothiazine and N,N- diethylhydroxylamine in a ratio of 1:10 to 1000:1 (see page 5, lines 6-12). The monomers are selected from styrene, alpha-styrene, meth (acrylic) acid and esters, 2-hydroxyethyl (meth) acrylate (see page 5, lines 16-27). EP teaches that the composition may also contain additional inhibitors such as nitrosphenylhydroxylamine (see page 5, lines 47-50). The composition may also contain UV absorbers and stabilizers (see page 5, lines 51-53). EP teaches the limitations of the claims other than the difference that is discussed below.

EP differs from the claims in that he does not specifically teach a monomers composition wherein both of the claimed inhibitors are present. However, it would have

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been obvious to one of ordinary skill in the art to have used both inhibitors because it is prima facie obvious to combine two components, each of which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose.

Claims 7, 11, 14-21, 23, 27, 35, 39 and 41-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

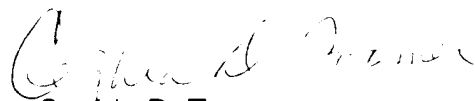
The prior art fails to teach or suggest the claimed (meth) acrylic acid amides; maleic acid derivatives; specific inhibitors or antioxidants or the specific solvents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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August 13, 2002